

## **REMARKS**

### **1. Summary of the Office Action**

In the Final Office Action mailed March 10, 2010, the Examiner objected to claim 13, rejected claims 1, 5, 7-9, 11-13, 15-20, and 22-26 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Chauvin (US Publication No. 2002/0030606) and McKeen (US Patent No. 6,529,880) references.

### **2. Status of the Claims**

Claims 1, 7, 8, 12, 13, 18, 19, and 23-26 have been amended by this response. Claims 27-31 are newly added. Currently pending are claims 1, 5, 7-9, 11-13, 16-20, and 22-31, of which claims 1, 7, 12, and 18 are independent.

### **3. Interview Summary**

Applicants thank the Examiner and his Supervisor for conducting the in-person interview on Tuesday, July 27, 2010. Participating in the interview was Applicant's representative Bradley J. Hulbert, Examiner Kelly, and Primary Examiner Daniel Hess. During the interview, Applicant's representative discussed the pending claims relative to the cited art. No agreement regarding allowability was reached. At the Examiner's request, Applicant agreed to provide amended claims after final that more clearly set forth the currently claimed invention.

### **4. Claim Rejections Under 35 U.S.C. § 103(a)**

In the last Office Action, claims 1, 5, 7-9, 11-13, 16-20, and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Chauvin and McKeen references. Applicants respectively traverse.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to

be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not. *MPEP* §2142 rev. 6 (October 2007).

*KSR International Co. v. Teleflex Inc.* requires that an Examiner provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," *Id.* The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* The Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." *Id.* at 1389. The rationale must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *Id.* at 1397. Anything less is not sufficient to sustain a prima facie case of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). Based upon *KSR* and *MPEP* § 2142, Applicants respectfully submit that the Examiner can not establish a *prima facie* case of obviousness, and therefore the Examiner's rejection should be withdrawn.

In the last Office Action, the Examiner conceded that Chauvin failed to teach any financial compensation. (See page 3 of the Office Action). In order to compensate for the failed teachings of Chauvin, the Examiner relied upon the McKeen reference to teach "causing a first party to be financially compensated by a second party for the network communications of a first device triggered by an RF chip based on an enabling ID."

At the Examiner's request, made during the July 27, 2010 Interview, Applicants have amended the claims to further clarify the "first party," the "second party," and the financial compensation aspect of the claims. Specifically, claim 1, for example, has been amended to require that the system comprise "a customer device configured to receive an RF signal from an RF chip via a first communication path, and responsively (i) start communicating with a communication network via a second separate communication path ... [and] means for causing an entity associated with the RF chip to be financially compensated by a communication provider associated with the communication network for the network communications of the customer device triggered by the RF chip, based at least in part on the enabling ID."

The McKeen reference, in contrast to the elements of the previously pending claim and as still set forth by the amended/clarified claim, fails to teach any financial compensation for the network communications of the customer device triggered by the RF chip. Rather, McKeen teaches compensation for products associated with RFID tags. As discussed during the July 27, 2010 Interview, compensating a party for the purchase of products labeled with an RFID tag does not amount to a network provider compensating an entity associated with an RF chip for triggering a customer device to use network communications resources associated with the network provider, as required by the claims.

Additionally, the "first party" in control of (or associated with) the RFID RF chip in McKeen is the purchaser. The purchaser in McKeen, however, is NOT compensated at all. Rather, it is the retailer who is compensated in McKeen. McKeen thus fails to teach means for causing the first party (e.g., the entity in the amended claims) to be financially compensated by the second party (e.g., the communication provider in the amended claims) for the network

communications of the first device triggered by the RF chip, based at least in part on the enabling ID.

For at least the forgoing reasons, Applicants respectfully submit that the Examiner did not establish a prima facie case of obviousness of claims 1, 5, 7-9, 11-13, 16-20, and 22-26, and can not establish a prima facie case of obviousness of the amended/clarified claims. Applicants therefore respectfully request that the rejections be withdrawn after-final, and a notice of allowance mailed allowing all claims.

## **5. Conclusion**

Applicants respectfully submit that, in view of the remarks above, independent claims 1, 7, 12, and 18 are allowable over the cited art of record. The remaining dependent claims are all dependent on these allowable independent claims and are therefore allowable for at least the reasons stated above.

If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned representative at (312) 913-0001.

Respectfully submitted,

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